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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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08/814,409 03/11/97 KITAJIMA

H 826.1377/JPH

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TM02/0126

EXAMINER

MEISLAHN, D

ART UNIT

PAPER NUMBER

2132
DATE MAILED:

01/26/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

08/814,409

Applicant(s)

Kitajima et al.

Examiner

Douglas Meislahn

Group Art Unit

2132

☒ Responsive to communication(s) filed on Nov 13, 2000

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claim

☒ Claim(s) 1-25 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1-25 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☒ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

DETAILED ACTION

Response to Amendment

1. This action is in response to the amendment filed 13 November 2000 that amended claims 1-6, 10-15, and 19-24.

Response to Arguments

2. Applicant's arguments with respect to claims 1-23 have been considered but are moot in view of the new ground(s) of rejection. Material has been added to the independent of the aforementioned claims. Applicant has not presented arguments as to the patentability of claims 24 and 25.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1-23 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

5. The term "substantially" in claim 1 is a relative term which renders the claim indefinite. The term "substantially" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. This limitation is in all of the independent claims from 1 through 23.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 23-25 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Dabbish et al. (4914697).

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 1-6, 8, 10-15, 17, and 19-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dabbish (4972478) in view of Knapp et al. (5499192) and the Microsoft Press Computer Dictionary, 3rd ed.

In the abstract, Dabbish discloses a "... logic cryptographic circuit that can be reprogrammed with various cipher algorithms." Reprogramming implies changing means. Changeable deciphering apparatus is mentioned in column 3, lines 44-46. Part 104 on Dabbish's diagram is communication circuitry, meaning that the apparatus can be connected to a communication network. In lines 51-67 of column one, Dabbish states that orders to change the encryption algorithm originate from sources external to the apparatus. He does not say that the change unit bases its decisions upon a

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mapping data object. Knapp et al.'s abstract and first four columns teach mapping data to programmable logic devices, saying that it can achieve greater convenience. Knapp et al. do not say that a data object implements the mapping, but the computer dictionary teaches object-oriented programming as common. Therefore it would have been obvious to a person of ordinary skill in the art at the time the invention was made to use the common object-oriented programming to map instructions, as taught by Knapp et al., to the reprogrammable circuit of Dabbish.

There is no mention in this of an enclosure substantially surrounding the electrical components. Official notice is taken that it is old and well known to shield electrical components from the environment by surrounding them within an enclosure. One example of this is the case in which computer components reside. Therefore it would have been obvious to a person of ordinary skill in the art at the time the invention was made to enclose the reprogrammable circuit, command unit, and changing means within protective material.

Claim 2's limitations are covered by Dabbish when the changes are considered in view of Knapp et al. Knapp et al. also teaches libraries and their associated elements in the paragraph spanning columns 3 and 4, thereby meeting claims 3, 4, and 6.

10. Claims 7 and 16 rejected under 35 U.S.C. 103(a) as being unpatentable over Dabbish, Knapp et al. and the computer dictionary as applied to claims 1 and 10 above.

Dabbish presents a system in which ciphering algorithms are written to a circuit, thus changing the algorithm that the circuit follows. Dabbish does not say that the algorithms are updated on a periodic basis. Official notice is taken that updating keys or

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other cryptographic devices is old and well known. Therefore it would have been obvious to a person of ordinary skill in the art at the time the invention was made to allow for periodic updates of the circuit, making it particularly useful in time specific applications such as pay television systems.

11. Claims 9 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dabbish, Knapp et al. and the computer dictionary as applied to claims 1 and 10 above, and further in view of Lynn et al. (5345508).

Dabbish presents a system in which ciphering algorithms are written to a circuit, thus changing the algorithm that the circuit follows. The instructions to change the algorithm and the algorithm itself come from sources external to the circuit. Dabbish does not mention changing the circuits specifications based upon the communication path, degree of communication path security, or the process speed required. Lynn et al. talk about changing encryption keys based upon processing time and security. They specifically describe how their invention can be used to balance these factors in the first paragraph of the brief summary, line 54 of column 2 through line 36 of column 3.

Therefore it would have been obvious to a person of ordinary skill in the art at the time the invention was made to allow for changes in the circuits specifications based upon the communication path, degree of communication path security, or process speed required. This would give flexibility to the system, letting it adapt to security and speed requirements.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Douglas J. Meislahn whose telephone number is (703) 305-1338. The examiner can normally be reached Monday through Thursday from 9:30AM to 7:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tod Swann can be reached on (703) 308-7791. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-9051 for regular communications and (703) 308-9052 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

Douglas J. Meislahn
Examiner
Art Unit 2132

DJM
January 24, 2001


TOD SWANN
SUPERVISORY PATENT EXAMINER
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